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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/116,876	07/16/98	ADHAM	N 53801/JPW/KD
			EXAMINER
HM12/0728			
JOHN F. WHITE COOPER & DUNHAM 1185 AVENUE OF THE AMERICAS NEW YORK NY 10036			DEVELOPER, G ART UNIT PAPER NUMBER 1647 7
DATE MAILED: 07/28/00			

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on the election of 12/6/99

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

Shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.6(a).

### Disposition of Claims

Claim(s) 1-9, 14-48, 71, 150, 208-223 is/are pending in the application.  
Of the above, claim(s) 1-9, 14-48, 150, 221-223 is/are withdrawn from consideration.  
Claim(s) \_\_\_\_\_ is/are allowed.  
Claim(s) 71, 208-220 is/are rejected.  
Claim(s) \_\_\_\_\_ is/are objected to.  
Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Specification Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Certified copies not received: \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5-8/99

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

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**1. Part III: Detailed Office Action for Restriction**

**2. Restriction Requirement:**

**First, Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A **dedicated** Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at 703-308-4310. Thank you in advance for allowing us to enhance our customer service. **Please limit the use of this dedicated Fax number to responses to Written Restrictions.**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 14-48, drawn to nucleic acids, vectors and host cells, classified in class 435 and 536, subclass 69.1 and 23.5 respectively.
- II. Claim 71, drawn to methods of identifying receptor binding compounds, classified in class 435, subclass 7.1.
- III. Claim 150, drawn to methods of modulating feeding behavior, classified in class 514, subclass 2+.

The inventions are distinct, each from the other because:

Inventions and are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the protein product can be made by a materially different method such as its isolation from nature using various isolation and purification procedures. It is further pointed out that these DNA and protein are physically and functionally distinct product, and that they are not required one for the other.

Inventions and are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein can be used other than in the methods specified, such as its use as a probe, to make antibodies, it could be used in various therapeutic methods, or it could be used in various diagnostic methods such as screening assay or affinity chromatography.

Inventions of Group and the method of Group are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA can be used other than in the production of the protein, such as its use as a probe, it could be used in various therapeutic methods such a gene therapy or to make transgenic animals, or it could be used in various diagnostic methods such as screening assay or hybridization.

**Furthermore**, the inventions are distinct, each from the other because:

It is further pointed out that although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for multiple/different products, restriction is deemed to be proper because the products appear to constitute patentably distinct inventions. The inventive products of Groups I and II are directed to products that are structurally, physically and functionally distinct and if determined to be patentable they would also be patentably distinct. Furthermore, these products are not required one for the other; nor is each of the products used in each of the methods.

In a similar manner it is further pointed out that although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for multiple/different methods,

restriction is deemed to be proper because the methods appear to constitute patentably distinct inventions. The inventive methods of Groups I, and Groups III and IV require the use of different steps/methods; elements/agents that are physically and functionally distinct; there are different starting elements and the final outcome/results are different for these different methods that cover various diagnostics and therapeutic methods; and if determined to be patentable they would also be patentably distinct. Furthermore, these methods are not required one for the other, nor does each of the methods require the use of each of the products.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications which are not co-extensive. And there are different issues for the search and examination of each group, which would be unduly burdensome, accordingly, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. A telephone call was made to John White on 9-21-99, 9-24-99, 9-27-99 to request an oral election to the above restriction requirement, but did not result in an election being made. The Pre-Amendment canceled many of the claims, with the majority of the remaining claims being directed to DNA, vectors and host cells. There were two other distinct methods of use that would constitute two other groups, and it was pointed out that these two different groups for methods were dependent from canceled claims and were improper-suggesting that the Group for the DNA was the only proper Group for examination, however, applicants still expressly requested that the restriction be written.

**4. Advisory Information:**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Garnette D. Draper, Art Unit 1646, whose telephone number is (703) 308-4232**. Examiner Draper can normally be reached Monday through Friday, 9:30 A.M. to 6:00 P.M.

Any inquiry of a general nature or relating to the status of this application or proceeding

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should be directed to the Group receptionist at telephone number (703) 308-0196.

Official papers filed by fax for this "Pilot for Written Restrictions" should be directed to (703) 305-3704-which is a Fax machine specifically for this pilot. Papers related to this application for election from the written restriction may be submitted to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED** so as to avoid the processing of duplicate papers in the Office.



GARNETTE D. DRAPER  
PRIMARY EXAMINER  
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